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In re Application of: )  
Dagnar Antoni-Zimmermann et al. ) Examiner : Jagoe, D.  
Serial No.: 09/509,932 ) Art Unit: 1614  
Filed : September 13, 2000 )  
)  
)

For : SYNERGISTIC BIOCIDIC COMPOSITION

New York, NY 10036  
August 7, 2002

Commissioner for Patents  
Washington, D.C. 20231

REQUEST FOR RECONSIDERATION

Sir:

This Request for Reconsideration is being filed in response to the Office Action that was mailed May 7, 2002.

In the first paragraph of the Office Action, the Examiner stated that the rejection over Valcke et al. under 35 U.S.C. §103 was maintained and repeated.

In making the rejection under 35 U.S.C. §103 in Paper No. 8, the Examiner commented that the claims were drawn to a biocide composition containing 2-methylisothiazolin-3-one (MIT) and 3-iodo-2-propynyl-N-butylcarbamate (IPBC) in combination and excluding 5-chloro-2-methylisothiazolin-3-one. The Valcke et al., reference was applied as teaching biocide compositions "comprising the active ingredients" and "further comprising other microbiocides such as 3-iodo-2-propynyl-N-butylcarbamate and isothiazolinones such as N-methylisothiazolin-3-one.

In response to this rejection, the claims were amended to point out that the claimed composition "consists essentially of" the recited ingredients. The accompanying REMARKS, in the Amendment dated February 1, 2002, pointed out that the language "consisting essentially of" was adopted to exclude the essential

components of the cited reference which are metconazole and a triazole.

In the Final Rejection, the Examiner is contending that the term "consisting essentially of" fails to exclude the presence of metconazole and a triazole from the applicants' amended claims because since metconazole is required by the Valcke et al. patent, it would not materially affect the instantly claimed composition which is fungicidal. In support of the rejection, the Examiner cited MPEP §2111.03.

MPEP §2111.03 explicitly points out that the term "consisting essentially of" limits the claim to the specified ingredients and to those ingredients that do not materially affect the basic and novel characteristics of a composition. The case of In re Herz and Willis, 190 USPQ 461 (Fed. Cir. 1986) was cited in MPEP §2111.03 as an illustration of how the term "consisting essentially of" is to be construed. For the Examiner's convenience, a copy of the Herz decision is attached to this Paper. At page 463, the court stated that:

"Therefore, in construing the phrase 'consisting essentially of', in appellants' claims it is necessary and proper to determine whether their specification reasonably supports a construction that would includes additives..." 190 USPQ at p.463 (emphasis added)

Based on the explicit language of the cited case, the Examiner must look to the applicants' specification and not to the specification of the cited reference in order to construe the meaning of the term "consisting essentially of". When the applicant's specification is reviewed, there is no mention of the addition of metconazole or a triazole. For this reason, the Examiner's construction of the applicant's claim is not correct and for this reason, the rejection of record should be withdrawn. (2)

In addition, any burden that the present applicant may have of showing that the introduction of the metconazole and triazole of the Valcke et al. reference into the applicants' composition, as defined by the claims before the Examiner, is discharged by the plain language of Valcke et al. That patent states that the invention is a "synergistic combination of

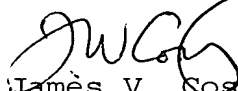
metconazole and another triazole". It is readily apparent that the addition of a synergistic combination of metconazole and a triazole would have a material effect on the applicants' claimed composition. It should be noted that the component that was held not to be excluded from the Herz composition was a dispersant and not a biologically active material. The applicants' specification in Herz included the use of a dispersant which is not the case with the present applicants' specification. (2)

The claims before the Examiner point out a composition consisting essentially of 2-methylisothiazolin-3-one and 3-iodo-2-propynyl-N-butylcarbamate and a polar or non-polar carrier. This composition is not made obvious by the Valcke et al. patent which explicitly requires that metconazole and at least one additional triazole fungicide also be present.

The Valcke et al. patent cites a great number of ingredients which may be used in the disclosed compositions but these materials are only used in combination metconazole and a triazole. There is no basis on which one skilled in the art would select the two components of the applicants' composition apart from all of the other disclosed components listed in the Valcke et al. patent. There is no teaching or direction in Valcke et al. that provides any motivation for one skilled in the art to select the MIT and IPBC compounds from the plethora of possible materials listed by Valcke et al. and use them in combination as defined in the claims before the Examiner.

For these reasons, it is requested that the rejection of record be withdrawn and all claims allowed. An early and favorable action is earnestly solicited.

Respectfully submitted,



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